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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,706	12/02/2003	Yoshihisa Tsukada	1982-0208P	1979
2292 7590 04/09/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
CHEA, THORL				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
04/09/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/724,706

Applicant(s)

TSUKADA ET AL.

Examiner

Thori Chea

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the communication on December 22, 2008; claims 1-18 are pending in this instant.
2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 of the US Application serial No. 09/953,958 filed September 18, 2001 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/953,958, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

See the reason presented in the Office action on September 23, 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as obvious over Tsukada et al (US 2002/0058220 A1).

Tsukada et al disclose photothermographic material contains a binder that can be formed by a combination of monomers having a carboxylic acid, a styrene and a conjugated diene. See conjugated diene on page 4, [0031], the monomer having carboxylic acid on page 5, [0034] to [0036] and the styrene and its derivative on page 5, [0038] wherein the amount of conjugate diene is within the range 10 to 70 % presented in the claimed invention. The conjugated dienes in [0031] is within the scope of the formula (M) claimed in the present claimed invention See for instance the 2,3-dimethyl-1,3-butadiene, and the percentage "x, y, z" on page 5, [0046]. The polymer is incorporated in the image forming layer. The polyhalogenate compound on page 19, formula (5) and pages 20-22 formula (5-1) to (5-40); the amount of organic polyhalogen compound on page 22, [0126]; and the binder has glass transition temperature T_g from -20 °C to 80 °C on page 5, [0045]. The conjugated diene (2,3-dimethyl-1,3-butadiene) contains a methyl group which is within the scope of R01 and R02 of the formula (M) when R01 and R02 contain an alkyl group with one carbon atom. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the conjugate diene taught in Tsukada et al including (2,3-dimethyl-1,3-butadiene) in combination with the monomer including that containing carboxylic acid and a styrene monomer with an expectation of achieving a polymer having binding property for the photothermographic material. The limitation such as R01 is hydrogen and R02 is a methyl group at the position (2,3) of the 1,3-butadiene presented in claims 13-15 may not specifically disclose in Tsukada et al, but the compound of formula (M) is within the generic 1,3-butadiene monomer taught Tsukada et al, and it would have been

obvious to the worker of ordinary skill in the art to 1,3-butadiene taught therein with an expectation of success. The isoprene taught in Tsukuda et al in [0032] is a compound " $\text{CH}_2=\text{CMe}-\text{CH}=\text{CH}_2$ " which is equivalent to the scope claimed of the present invention (claim 13-15) " $\text{CH}_2=\text{CH}-\text{CMe}=\text{CH}_2$ ".

Response to Arguments

5. Applicant's arguments filed December 22, 2008 have been fully considered but they are not persuasive. The invention as claimed would have at least found prima facie obvious over Tsukada et al for the reason set forth above. Tsukada et al clearly suggest the formation of a polymeric binder using the conjugate diene, the monomer having carboxylic group and a styrene monomer. It would have been obvious to the monomers or the combination of monomers suggested therein to form a polymeric binder for photothermographic material. Tsukada et al discloses the improvement of the photothermographic material containing such as good storability former to image forming and good coating property on page 1, [0006].

With respect to the claiming of the benefit of the priority to prior failed application serial no. 09/953,958 the applicants argue that "he claims. Applicants respectfully submit that the present invention is supported in Tsukada '220, and this finding by the Examiner is improper. Reconsideration is requested as a sufficient number of species is disclosed to support the instantly claimed formula (M). In any event, the present claim amendments distinguish over the disclosure of Tsukada '220.

The argument is not persuasive. The applicants fail to clearly explain as to why the disclosure of the invention in the parent application and in the later-filed application must be sufficient to

comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The parent application 09/953,958 fails to disclose the compound of formula (M) claimed in the present claimed invention including the amount thereof. The parent application 09/953,95 is related to polymeric binder containing a formula (I), rather than the compound of formula (M). See page 5. The present patent application and the previously application are unrelated.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC
2009-03-31

/Thorl Chea/
Primary Examiner, Art Unit 1795